

### **REMARKS**

Upon entry of the instant Response and Amendment, Claims 1-10 and 12-25 will remain pending in this application.

In the Office Action mailed August 14, 2008, Claims 1-10 and 12-25 are rejected under 35 U.S.C. §102(b), as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,822,045 issued to Miyatake et al. Claims 1-10 and 12-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,822,045 issued to Miyatake et al.

#### **Rejections under 35 U.S.C. §§102(b)/103(a) as anticipated and/or rendered unpatentable by Miyatake et al.**

Claims 1-10 and 12-25 stand rejected under 35 U.S.C. §102(b), as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,822,045 issued to Miyatake et al. Beginning at page 2 of the Final Office Action mailed August 14, 2008, the Examiner states,

Patentees disclose a process in which a latex "A" (referred to as a "silicone rubber" but containing both containing acrylic as well as crosslinked silicone polymers) are coagglomerated with a latex "B" while conducting polymerization of vinyl rubbers, i.e. grafting is taking place during coagglomeration and as such the graft copolymers formed during the process would be coagglomerated. Note the Abstract in this regard. Redox polymerization is preferred for production of "B" at column 10, lines 41-43. Both "A" and "B" may be crosslinked at column 7, lines 17-20 as well as column 9, lines 33-36. It is noted that applicants "consisting of" language only pertains to materials used in a redox system and do not exclude materials present in non redox systems such as may possibly be present in patentees' final cografting step. In any case no evidence has been presented that the products of redox and non redox persulfate polymerization differ and as both types of systems result in addition polymerized acrylates the product of patentees and applicants would reasonably appear to be the same.

Product-by-process claims are not rejected using the approach set out in Graham v. Deere. It is applicant's burden to show that there is a non-obvious difference between the product of a product-by-process claim and a prior art product which reasonably appears to be the same or only slightly different whether or not the prior art product is produced in the same manner as the claimed product. Note In re Marosi, 218

USPQ 289, 292-293 (CAFC 1983); *In re Brown*, 173 USPQ 685 (CCPA 1972) and *In re Thorpe*, 227 USPQ 964 (CAFC 1985) in this regard.

Applicants respectfully disagree with the Examiner's contention regarding Miyatake et al. and remind the Examiner that as stated in MPEP §2131, to anticipate a claim, a reference must teach every element of that claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully contend that the Examiner has failed to point to where Miyatake et al. do so.

Applicants respectfully remind the Examiner of the Federal Circuit's admonition given against hindsight reconstruction in *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1458-9 (Fed. Cir. 1998) that, "...the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." Applicants respectfully contend that the Examiner has failed to do so in the Final Office Action mailed August 14, 2008.

Applicants have amended Claim 1 to more clearly recite that each of B.1 and B.2 is a graft polymer in latex form, (each containing a graft base and a grafted polymerized phase of at least one vinyl monomer) that after its polymerization is mixed with its counterpart to form a mixture and the mixture subsequently co-precipitated (i.e., **"(B) a co-precipitated mixture of,"**). Support for such amendment being found in the Specification at least at page 18, lines 7-12. In contradistinction, Miyatake et al. disclose a rubber modified resin that is obtained "by polymerizing a vinyl monomer in the presence of (A) a silicone rubber latex and (B) an acrylic rubber latex and during polymerization co-agglomerating polymer particles to enhance the particle size" (col. 2, line 17 *et seq.*, also col. 11, line 25 *et seq.*).

The requirement of Miyatake et al. that the polymerization of vinyl monomers be carried out in the presence of both rubbers cannot be seen as describing or fairly suggesting the instantly recited invention wherein each of the rubbers undergoes polymerization separate from the other.

Therefore, applicants respectfully request the Examiner reconsider and reverse his rejection of Claims 1-10 and 12-25 under 35 U.S.C. §102(b), as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,822,045 issued to Miyatake et al.

Rejections under 35 U.S.C. §103(a) as being rendered unpatentable by Miyatake et al.

Claims 1-10 and 12-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,822,045 issued to Miyatake et al. beginning at page 3 of the Final Office Action mailed August 14, 2008, the Examiner states,

No examples of processes having all of applicants limitations including use of redox polymerization to produce patentees "B" which applicants may argue has a material effect on the product produced as compared to non redox or use of combinations of redox, non redox polymerization. However choice of applicants various limitations from the patent would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention in the expectation of adequate results absent any showing of surprising or unexpected results.

It is noted that applicants newly added limitation to claim 1 was not present in any of the claims under appeal including claim 11 and therefore the allowability of claim 1 over Kempner is not contrary to the decision of the Board of Appeals. Applicants newly added limitation is not taught or suggested by Kempner and Kempner is therefore now no longer relied upon.

Applicant's arguments filed 5-1 2-08 have been fully considered but they are not persuasive. Applicants argue that the instant claims distinguish over Miyatake in that the instant invention requires that "each of the rubbers undergoes polymerization separate from each other" and that "two graft polymers are required to be first made and then, after polymerization, mixed and the resulting mixture co-precipitated". However, the claims define the invention and no such limitations appear in the claims.

Applicants' remarks with respect to the deficiencies of Miyatake et al. are given above and will not be repeated here in the interests of conserving the Examiner's time. Miyatake et al. fail to teach or fairly suggest the instantly claimed invention.

Therefore, Applicants contend that nothing in the teaching of name would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse his rejection of Claims 1-10 and 12-25 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 6,822,045 issued to Miyatake et al.

### **CONCLUSION**

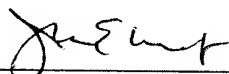
Applicants have amended Claim 1. Such amendment adds no new matter and finds support in the specification.

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 1-10 and 12-25. If the Examiner is of the opinion that the instant application is in condition for other than allowance, he is requested to contact the Applicants' attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

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